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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/437,216	11/10/1999	YOSHIHIRO TERADA	046601-5028	7662

9629 7590 05/04/2005

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EXAMINER	
BRINICH, STEPHEN M	
ART UNIT	**PAPER NUMBER**
2624	

DATE MAILED: 05/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
09-437216			

EXAMINER	
ART UNIT	PAPER
	20050419

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner for Patents

Office Action Summary	Application No.	Applicant(s)	
	09/437,216	TERADA ET AL.	
	Examiner	Art Unit	
	Stephen M Brinich	2624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on *10 September 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-7 and 9-15* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *4,13 and 14* is/are allowed.

6)☒ Claim(s) *1-3,5-7,10,12 and 15* is/are rejected.

7)☒ Claim(s) *9 and 11* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 1-3, 5-6, 10, 12, & 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hayashi et al (5471281) in view of Lopresti et al.

Re claims 1, 5, 10, 12, & 15, Hayashi et al '821 discloses (column 13, lines 41-53; column 18, line 66 - column 19, line 16; column 20, lines 16-26) an image processing arrangement in which a scanning system generates image data from an original document and a discriminating system immediately (at the time of scanning and prior to recording the image) determines whether a predetermined inhibit image is present in the original image. An editing system then alters the image data (which at this point includes the inhibited image data), e.g. replacing the inhibited image region with a specific color, if this inhibit image is found, in order to produce an output image.

Alternatively, the editing system leaves image data in which no inhibit image is found unaltered in the produced output image. A printout system stores the output of the editing system as hard copy.

Re claims 2-3, a removal or substitution of certain image elements inherently affects the order in which the elements are read out afterwards (by removing the deleted or replaced elements from the sequence).

Re claim 6, the Hayashi et al '821 scanner is a "predetermined image input system", inasmuch as it is known in advance that images to be processed will be supplied to the image processing system by this means.

Hayashi et al '281 does not disclose expressly the electronic storage of the final output image (but rather discloses the paper hard-copy storage of this image).

Lopresti et al discloses (column 7, lines 4-11) an image processing arrangement in which an original document is scanned and processed. The final resulting image may be stored as a paper hard copy, as an electronically stored image, or both, as the user selects.

Hayashi et al '281 and Lopresti et al are combinable because they are from document scanning and copying.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to provide the option of paper or electronic (or both) output, as taught by Lopresti et al, in the Hayashi et al '281 document handling system.

The suggestion/motivation for doing so would have been to enable a user to obtain either a paper hard copy, an electronically stored copy, or both, in accordance with the user's needs (e.g. immediate reading of a few pages would be more easily done with paper hard copies; transportation of a large number of documents to another location would be more easily done with electronically stored copies).

Therefore, it would have been obvious to combine Hayashi et al '281 with Lopresti et al to obtain the invention as specified in claims 1-3, 5-6, 10, 12, & 15.

Claim Rejections - 35 USC § 103

3. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hayashi et al '821 in view Lopresti et al, and further in view of Applicant's described Prior Art.

Re claim 7, Hayashi et al '821 discloses a local inputting of image data (by scanning an original document) without the use of an "external device". The connection of external devices to send and receive image data in conjunction with confidential-image printout suppression is known in the art as shown for

example by Applicant (Figure 13; page 2, lines 7-15). The use of the Hayashi et al '821 image processing system to process image information from an external device in order to allow remote users to print edited documents would be an expedient obvious to one of ordinary skill in the art.

Allowable Subject Matter

4. Claims 4 & 13-14 are allowed.

5. Claims 9 & 11 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

6. The following is a statement of reasons for the indication of allowable subject matter:

Re claim 4, the art of record does not teach or suggest the claimed selective image rotation in accordance with the output of an image selectively edited in response to the detection of an inhibit image.

Re claims 9, 11, & 13 (and dependent claim 14), the art of record does not teach or suggest the inversion of a gradation of a color signal in an inhibited image data portion.

Response to Arguments

7. Applicant's arguments, see Response filed 9/10/04, with respect to the rejection(s) of claim(s) 1-3, 5-6, 12, & 14-15

under 35 USC §102 and of claim 7 under 35 USC § 103 have been fully considered and are persuasive in view of the amendments to claims 1, 5, 13, & 15 (from which claims 2-3, 6-7, 12, & 14 depend). Therefore, the rejection has been withdrawn. However, upon further consideration of the claims as amended, a new ground(s) of rejection of claims 1-3, 5-6, 10, 12, & 15 is made in view of Hayashi et al '821 in view of Lopresti, and a new ground of rejection of claim 7 is made in view of Hayashi et al '821 in view of Lopresti, and further in view of Applicant's described Prior Art.

The rejection of claim 8 has been rendered moot by the cancellation of this claim.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened

statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen M. Brinich at 571-272-7430. The examiner can normally be reached on weekdays 7:00-4:30, alternate Fridays off.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Tech Center 2600 Customer Service center at 571-272-2600 or to the USPTO Contact Center at 800-786-9199 or 703-308-4357.

If attempts to contact the examiner and the Customer Service Center are unsuccessful, supervisor David Moore can be contacted at 571-272-7437.

Faxes pertaining to this application should be directed to the Tech Center 2600 official fax number, which is 703-872-9306.

Hand-carried or courier-delivered correspondence pertaining to this application should be directed to

US Patent and Trademark Office
220 South 20th Street
Crystal Plaza Two, Lobby, Room 1B03
Arlington VA 22202

Stephen M Brinich
Examiner
Art Unit 2624

smb
April 19, 2005

THOMAS A LEE
PRIMARY EXAMINER